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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,578

03/02/2004

David George Putman

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07/24/2006

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EXAMINER

BERNHARDT, EMILY B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,578

Applicant(s)

PUTMAN, DAVID GEORGE

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,8-16,28,29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8,9,11-16,28,29 and 32 is/are rejected.
- 7) ☒ Claim(s) 10 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicants' response filed 5/16/06 the following applies.

Applicant's election without traverse of Group I in the reply filed on 5/16/06 is acknowledged.

Applicants request rejoinder of nonelected method claims should compound claims be in condition for allowance. The claims remain rejected in part as set forth below. However in a telephone conversation held with Mr. Hall on 7/19/06 concerning the method of use claims, the examiner indicated that such uses as currently claimed would raise additional 112 issues based on the scope of uses being covered including whole classes of disorders. The examiner would not object to a new claim directed to "enhancing cognitive memory in Alzheimer's patients" as this has been correlated to 5-HT 6 antagonism and canceling claims 33-35. Claim 36 would also be rejoined once elected subject matter is allowed but note the extraneous "f" appearing in the formula and the "G" definition has been deleted. Also the claim should be made more legible by increasing the font size as the superscripts are hard to discern.

Claims 14, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 14 is not seen to further limit the scope of claim 1 as now amended to elected subject matter. If applicants disagree they should point to a difference in scope.

2. Claims 28 and 29 appear now to be substantial duplicates in view of the main claim being limited to elected subject matter and further narrowed to overcome the prior art.

Claims 1,2,6,8,9,11-16,28,29 and 32 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While applicants have amended the claims to address this rejection, the scope at R2 remains not adequately enabled. As discussed in the previous office action “aryl” as R2 entails not only phenyl, naphthyl but a range of polyfused carbocyclics as well as hetero-containing rings as set forth on p.5 of the specification. Additionally, the nature of substituents thereon is virtually nonlimiting with “acyl” groups not particularly defined but included within the ambit of acylamino and heteroalkyl groups as described on p.7 of the specification. Note that claim 10 is not rejected herein.

Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In reviewing the species covered by this claim note the last entry corresponds to R2 as a heteroaryl which has been deleted from claim 1 in response to the scope of claim rejection. Additionally it is noted that the 2nd and 4th last entries recite substituents on phenyl ring (as R2) not particularly described in the specification and thus not clearly within the ambit of claim 1. See “methanesulfonyl” and “urea” in these species. It is suggested the claim be made independent.

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Note the typo on the last line on p.4 for first choice. Note the “l” missing after “...pheny” .

The rejection over Ohkura is overcome by applicants' amendments limiting Y to SO₂.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Art Unit: 1624

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Emily Bernhardt
Primary Examiner
Art Unit 1624